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William J. Dupre

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MARSHALL, GERSTEIN & BORUN LLP
233 S. WACKER DRIVE, SUITE 6300
SEARS TOWER
CHICAGO, IL 60606

EXAMINER

MURDOUGH, JOSHUA A

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3621

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/727,783	Applicant(s) DUPRE ET AL.	
	Examiner JOSHUA MURDOUGH	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-84 is/are pending in the application.
- 4a) Of the above claim(s) 19-84 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/27/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 1-84 are pending.
2. Claims 19-84 are withdrawn from further consideration pursuant to 37 C.F.R. §1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on 6 June 2008.

3. Accordingly, claims 1-18 have been examined.

Drawings

4. The drawings are objected to as failing to comply with 37 C.F.R. §1.84(p)(5) because they include the following reference character not mentioned in the description: “40”.
5. The drawings are objected to under 37 CFR 1.83(a) because they fail to show “one or more dedicated communication server(s) and one or more dedicated payment processing server(s)” as described in paragraph 18 of the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d).
6. The drawings are objected to under 37 C.F.R. §1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “intermediate server” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
7. Corrected drawing sheets in compliance with 37 C.F.R. §1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet,

Art Unit: 3621

even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

- a. “the intermediate server” in at least claim 1;
- b. “stripping the invoice transaction record from the transmitted transaction log” in at least claim 1;
- c. “UPC” in at least claim 10;

9. Appropriate correction is required.

Claim Rejections - 35 USC § 112 1st Paragraph

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

d. “[F]lagging the invoice transaction record,” as claimed in line 15 of claim 1 is only discussed in paragraphs [0017] and [0029] of the instant application. However, there is no discussion as to how the flagging is performed, other than to say it is by "User Exit Program 2." If Applicants admit that flagging as performed in the instant invention is old and well known in the art and provide a reference in support of this statement, this rejection will be withdrawn.

e. “[S]tripping the invoice transaction record from the transmitted transaction log,” as claimed in line 17 of claim 1 is not claimed in a manner to show that the process required to perform the limitation was in the possession of the Applicants. Moreover, stripping is not mentioned in the instant specification. If Applicants admit that stripping as performed in the instant invention is old and well known in the art and provide a reference in support of this statement, this rejection will be withdrawn.

Art Unit: 3621

f. "[T]he data identifying the biller is entered as a product look-up code (PLC)," as claimed in lines 1-2 of claim 8. The specification lacks the disclosure to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, could derive the biller's identity from a PLC which is unique to the product not the seller.

g. "[T]he data identifying the biller is entered as a UPC code," as claimed in lines 1-2 of claim 10. The specification lacks the disclosure to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, could derive the biller's identity from a Universal Product Code which is unique to the product not the seller.

Claim Rejections - 35 USC § 112 2nd Paragraph

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

h. Claim 1 recites the limitation "an other item" in lines 8 and 9. There is insufficient antecedent basis for this limitation in the claim. Nowhere in the claim is a first item shown for there to be an other.

Art Unit: 3621

i. Claim 1 recites the limitation "the intermediate server" in line 18. There is insufficient antecedent basis for this limitation in the claim. For purposes of prior art, the Examiner has interpreted this limitation to refer to the "processing server" in line 16.

j. Claim 1 missing essential elements. See MPEP § 2172.01. The omitted structural cooperative relationships are: where the payment is tendered. For purposes of prior art, the Examiner has interpreted the tendering of payment to occur at the cashier's terminal.

k. Claim 1 is also missing essential steps. See MPEP § 2172.01. The omitted steps are: transferring the payment from the cashier's terminal at the outlet to the central station in order for the central station to be able to make the payment to the biller.

l. Claim 1 recites "stripping the invoice transaction record from the transmitted transaction log" in line 17. The steps taken to perform this are not shown in the claim nor are they present in the specification. Therefore, one of ordinary skill in the art would not understand the steps that must be performed in order to infringe this claim.

m. Claim 1 recites "determining a total amount of money due as a result of the invoice transaction and the other transaction," in lines 10-11. However, in lines 8-9, the other transaction is shown to be optional, "if an other item is to be purchased."

Therefore, the scope of the claim is not readily understood by one of ordinary skill in the art for the case where an other item is not purchased. For purposes of prior art, the Examiner has interpreted the other transaction as not being required in either step.

n. Claim 1 recites "flagging the invoice transaction record" in line 15. As noted above, the steps involved in flagging are not set out by the claim or the specification. Therefore, one of ordinary skill in the art would not know what steps are required to

Art Unit: 3621

infringe on the claim. For purposes of prior art, the Examiner notes that the existence of a flag is not pertinent to any other step of the method recited, therefore it has been considered non-functional descriptive material.

o. The term “product look-up code” in claims 8-9 is used by the claim to mean “a biller code”, while the accepted meaning is “a 4 to 5 digit code for identifying produce or other variable weight items.” Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “product look-up code” in claims 8-9 is used by the claim to mean “a biller code”, while the accepted meaning is “a 4 to 5 digit code for identifying produce or other variable weight items.” The term is indefinite because the specification does not clearly redefine the term.

p. The term “UPC” in claims 10-11 is used by the claim to mean “a code identifying the biller”, while the accepted meaning is “a Universal Product Code, which is a unique numeric 12-digit barcode on a product use for inventory control.” The term is indefinite because the specification does not clearly redefine the term.

q. As to claim 18, Applicant again refers to the “other transaction.” As noted above, the other transaction is considered to be optional and therefore, not necessarily present. When it is not present, there cannot be a billee for it as claimed. For purposes of prior art, this limitation has been interpreted as “generating a receipt for the billee of

Art Unit: 3621

the invoice transaction” when no other transaction is present. Appropriate correction is required.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1-18, as understood by the Examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by the American Bankers Association (“ABA”) (The Bank Credit Card Business).

16. As to claim 1, ABA shows:

r. For an organization having a central station and a plurality of distributed outlets, each of the outlets having a cashier's terminal, each of the cashier's terminals coupled to a respective point-of-sale (POS) controller, a method of permitting a billee to pay an invoice issued by a biller, the method comprising:

s. conducting an invoice transaction by entering data identifying the biller and the billee (inherent to paying a bill as shown in Exhibit 2.1, page 18) into one of the cashier's terminals (at Cardholder Bank Exhibit 2.1, page 18), and entering data indicating an amount of money to be paid by the billee towards the invoice into the one of the cashier's terminals (\$100 Payment; Exhibit 2.1, page 18);

Art Unit: 3621

- t. if an other item is to be purchased, conducting an other transaction by entering data identifying the other item to be purchased into the one of the cashier's terminals (another item is not shown by Exhibit 2.1, page 18, therefore an other item is not to be purchased);
- u. determining a total amount of money due as a result of the invoice transaction and the other transaction (\$100 Bill; Exhibit 2.1, page 18);
- v. tendering payment for the amount due (\$100 Payment; Exhibit 2.1, page 18);
- w. creating an electronic transaction log including an invoice transaction record of the invoice transaction (detailed record of transactions, Page 13, partial paragraph);
- x. flagging the invoice transaction record (descriptive material, see below);
- y. transmitting the transaction log from the POS controller (at Cardholder Bank; Exhibit 2.1, page 18) to a processing server (Association; Exhibit 2.1, page 18);
- z. stripping the invoice transaction record (settlement info) from the transmitted transaction log ; and
- aa. transmitting the stripped invoice transaction record (Settlement; Exhibit 2.1, page 18) from the intermediate server (Association; Exhibit 2.1, page 18) to a central server (Merchant Bank; Exhibit 2.1, page 18), wherein the central server determines from the transmitted, stripped invoice transaction record, the amount of payment due to the biller (\$97), and instructs the central station to forward payment to the biller (Merchant; Exhibit 2.1, page 18).

17. As to claim 2, ABA further shows:

Art Unit: 3621

the central server generates a notification to the biller indicating the amount paid by the billee towards the invoice (the biller, or acquirer, is given notice of the fees collected, and therefore knows by the amount of the payment to them, what was paid by the billee; (Page 17, paragraphs 1-2).

18. As to claim 3, ABA further shows:

the transaction log includes a plurality of transaction records, each having a respective invoice transaction record, which invoice transaction records are stripped and transmitted to the central server (detailed record of transactions, Page 13, partial paragraph).

19. As to claim 4, ABA further shows:

the invoice transaction includes an addition of a service fee to the amount of money to be paid towards the invoice ($\$100.00 - \$97.00 = \$3$ fee; Exhibit 2.1, page 18).

20. As to claim 5, ABA further shows:

the central server instructs the central station to pay a third-party an amount of the service fee (Association and Merchant Bank each receive \$1.50 of the \$3 fee; Exhibit 2.1, page 18).

21. As to claim 6, ABA further shows:

the processing server is operated by the third party (Association is Visa International or MasterCard International; Duality, beginning on page 18).

Art Unit: 3621

22. As to claim 7, ABA further shows:

the central server is operated by the third party (Merchant's Bank; Exhibit 2.1, page 18).

23. As to claims 8-11, the claims do not make sense because they are attempting to use a product code to identify a biller. As the product codes only contain product information, it is impossible to identify the biller from them. Therefore, these claims are rejected under the same basis as claim 1.

24. As to claim 12, ABA further shows:

the transaction log is transmitted to the processing server on a daily basis (Posting is performed daily; Page 83, paragraph 2).

25. As to claim 13, ABA further shows:

the stripped invoice transaction record is transmitted to the central server when the invoice transaction record has been stripped from the transaction log (settlement only involves the financial, or invoice transaction, data, therefore it necessarily has been stripped out of the transaction log; Page 207, definition of settlement).

26. As to claim 14, ABA further shows:

the stripped invoice transaction record is transmitted from the processing server to the central server by a direct modem connection (dial-up terminal, Page 123, paragraph 4).

Art Unit: 3621

27. As to claim 15, ABA further shows:

the stripped invoice transaction record is transmitted from the processing server to the central server by an internet connection (Page 159, paragraph 4).

28. As to claim 16, ABA further shows:

the organization is a grocery store chain (this does not modify the steps to be taken, therefore it is considered intended use. If the method were performed in another location, there would still be infringement. Therefore, this claim is rejected under the same basis as claim 1.).

29. As to claim 17, ABA further shows:

each of the outlets has a plurality of cashier's terminals coupled to a respective POS controller (POS terminals found in merchant outlets, Page 123, paragraph 4).

18. (Original) The method of claim 1 including generating a receipt for the billee of the invoice transaction and the other transaction (Receipt, beginning on page 81).

Claim Rejections - 35 USC § 103

30. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

31. Claims 8-11 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over ABA in view of Official Notice.

Art Unit: 3621

32. As to claims 8-11, ABA shows as discussed above in reference to claim 1, but does not expressly show a merchant code. However, the Examiner takes Official Notice that it is notoriously old and well known in the art to assign an account number, or code, to each party in an electronic transaction which can be input through a keypad or other input means, because this ensures a unique, yet uniform, handle for each of the parties. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add to the teachings of ABA to include a merchant code in order to provide automated processing of the payments.

Claim Interpretations

33. Applicant(s) are reminded that optional or conditional elements (*e.g.* claim 1 which recites “if an other item is to be purchased”) do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C.: “Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]”; and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) (“As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.”).

34. If a positive recitation is desired and if Applicant(s)' original specification supports such an amendment, the Examiner respectfully suggests amending the claim to remove the quoted portion.

Art Unit: 3621

Conclusion

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

36. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

37. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J. M.
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621